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OFFICE OF PETITIONS

In re Application of :
Deo et al. :
Application No. 10/035,637 : ON APPLICATION FOR
Filed: November 7, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. CDJ-166CPRCE :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 CFR §1.705(b) filed on November 26, 2008. Applicant requests that the determination of patent term adjustment be corrected from zero (0) days to four hundred seventy two (472) days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined¹. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

¹ The computer will also enter any additional periods of adjustment for Office delay and any additional periods of reduction for applicant delay after the mailing of the notice of allowance, such as pursuant to 37 CFR 1.703(a)(6) for Office delay and 37 CFR 1.704(c)(10) for applicant delay.

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was first filed in this application on March 30, 2006.

To the extent that the instant application for patent term adjustment requests reconsideration of the PTA at the time of

the mailing of the Notice of Allowance, the request is **GRANTED TO THE EXTENT INDICATED.**

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On October 1, 2008, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was zero (0) days. The period of adjustment was 442 days of PTO delay and 448 days of applicant delay.

On November 26, 2008, the issue fee was paid. The subject application for term patent adjustment was filed concurrently with the issue fee, and was therefore timely filed.

Applicant asserts that a period of 113 days, rather than a period of eight (8) days, should be entered pursuant to 37 CFR 1.703(a)(2) in connection with the mailing of the non-final Office action mailed on December 7, 2004. The office calculated a period of eight (8) days of delay for the mailing of the office action on December 7, 2004, four (4) months and eight (8) days after the filing of a reply on July 29, 2004. Applicant, however, asserts that the office action mailed on December 7, 2004, was in response to the reply filed on April 16, 2004, and was mailed four (4) months and 113 days after the filing of the reply filed on April 16, 2004. Applicant further states that the reply filed on July 29, 2004, was in response to an Office letter mailed on June 29, 2004 which requested correction of the sequence disclosures.

A review of the record supports a conclusion that the non-final Office action mailed on December 7, 2004 was mailed in response to the reply filed April 16, 2004, four months and 113 days after the filing of the reply filed on April 16, 2004. Accordingly entry of a period 113 days of adjustment, rather than a period of eight (8) days of adjustment, is warranted.

Applicant further states that a period of reduction of 104 days should be entered for the filing of a supplemental reply pursuant to 37 CFR 1.704(c)(8) in the form of an information

disclosure statement (IDS) filed on July 29, 2004, which was filed 104 days after the filing of a reply on April 16, 2004.

A review of the record reveals that an IDS was filed on July 29, 2004, 104 days after the filing of the reply filed on April 16, 2004.

37 CFR 1.704(c)(7) states that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping: Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

37 CFR 1.704(d) states that a paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

The IDS did not contain the statement set forth at 37 CFR 1.704(d).

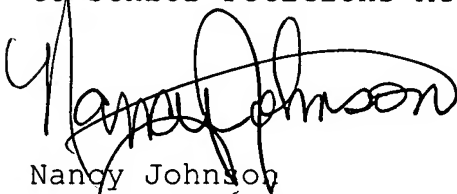
Accordingly, entry of a period of reduction of 104 days is warranted.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is zero (0) days (547 (434+113) days of office delay less 552 (104+64+93+91+86+76+38) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name and title.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

PTA Calculations for Application: 10/035637

Application Filing Date:	11/07/2001	PTO Delay (PTO):	442
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	448
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	1		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
119	06/08/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		104	
118	06/08/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		8	
117	06/08/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	113		
104	10/01/2008	MAIL NOTICE OF ALLOWANCE			
103	09/29/2008	ISSUE REVISION COMPLETED			
102	09/29/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
101	09/29/2008	CASE DOCKETED TO EXAMINER IN GAU			
100	09/25/2008	DOCUMENT VERIFICATION			
99	09/25/2008	NOTICE OF ALLOWABILITY			
98	09/02/2008	PARALEGAL TD ACCEPTED			
97	08/12/2008	TERMINAL DISCLAIMER FILED		0	95
96	08/30/2008	DATE FORWARDED TO EXAMINER			
95	08/12/2008	AMENDMENT AFTER FINAL REJECTION			
94	08/11/2008	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
93	08/06/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
92	06/12/2008	MAIL FINAL REJECTION (PTOL - 326)			
91	06/09/2008	FINAL REJECTION			
90	04/23/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
89	04/23/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		38	86
88	04/23/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
87	04/18/2008	DATE FORWARDED TO EXAMINER			
86	03/16/2008	RESPONSE AFTER NON-FINAL ACTION			

85	01/30/2008	MAIL NON-FINAL REJECTION			
84	01/28/2008	NON-FINAL REJECTION			
83	11/23/2007	DATE FORWARDED TO EXAMINER			
82	10/24/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
81	11/23/2007	DATE FORWARDED TO EXAMINER			
80	10/24/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		76	73
79	11/23/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
78	10/24/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
77	10/24/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
76	09/05/2007	CORRESPONDENCE ADDRESS CHANGE			
75	07/01/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
74	07/01/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
73	05/09/2007	MAIL FINAL REJECTION (PTOL - 326)			
72	05/07/2007	FINAL REJECTION			
71	11/22/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
70	03/05/2007	DATE FORWARDED TO EXAMINER			
69	02/16/2007	RESPONSE AFTER NON-FINAL ACTION		86	63
68	02/06/2007	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
67	11/22/2006	REFERENCE CAPTURE ON IDS			
66.7	11/22/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
66	11/22/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
65	11/22/2006	NEW OR ADDITIONAL DRAWING FILED			
64	12/11/2006	DATE FORWARDED TO EXAMINER			
63.1	11/22/2006	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
63	11/22/2006	RESPONSE AFTER NON-FINAL ACTION		91	59
62	11/22/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
60	11/30/2006	ERROR(S) IN CRF CORRECTED BY STIC			
59	05/23/2006	MAIL NON-FINAL REJECTION			

58	05/22/2006	NON-FINAL REJECTION			
57	03/30/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
56	03/30/2006	REFERENCE CAPTURE ON IDS			
55.7	03/30/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	51
55	03/30/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
54	04/06/2006	DATE FORWARDED TO EXAMINER			
53	03/30/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
52	04/06/2006	DATE FORWARDED TO EXAMINER			
51	03/30/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
50	04/06/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
49	03/30/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
48	01/30/2006	NOTICE OF APPEAL FILED		93	46
47	01/30/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
46	07/29/2005	MAIL FINAL REJECTION (PTOL - 326)			
45	07/26/2005	FINAL REJECTION			
44	05/24/2005	DATE FORWARDED TO EXAMINER			
43	05/10/2005	RESPONSE AFTER NON-FINAL ACTION		64	41
42	05/10/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
41	12/07/2004	MAIL NON-FINAL REJECTION	8		36
40	12/07/2004	NON-FINAL REJECTION			
39.7	07/29/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
39	07/29/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
38	07/29/2004	NEW OR ADDITIONAL DRAWING FILED			
37	08/12/2004	DATE FORWARDED TO EXAMINER			
36	07/29/2004	RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES			
35	07/19/2004	RULE 47 / 48 CORRECTION OF INVENTORSHIP PAPERS FILED			
28	07/19/2004	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
27	07/19/2004	MISCELLANEOUS INCOMING LETTER			

26	07/29/2004	WORKFLOW INCOMING AMENDMENT IFW			
25	07/19/2004	WORKFLOW INCOMING PETITION IFW			
24	06/29/2004	MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED)			
23	06/25/2004	CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED			
22	05/07/2004	DATE FORWARDED TO EXAMINER			
21	04/16/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
20	03/16/2004	MAIL RESTRICTION REQUIREMENT	434		-1
19	03/15/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
18	12/19/2003	CORRESPONDENCE ADDRESS CHANGE			
17	07/09/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
15.7	05/06/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	05/06/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	10/31/2002	CASE DOCKETED TO EXAMINER IN GAU			
13	09/26/2002	APPLICATION DISPATCHED FROM OIPE			
12	09/26/2002	APPLICATION IS NOW COMPLETE			
11	06/18/2002	ADDITIONAL APPLICATION FILING FEES			
10	06/18/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
9	06/18/2002	OMMITTED SPECIFICATION PAGES. APPLICANT HAS PETITIONED THAT THE FILING DATE NOT BE CHANGED AND THE P			
8	08/05/2002	MAIL-RECORD PETITION DECISION OF GRANTED RELATED TO FILING DATE			
7	06/18/2002	PETITION ENTERED			
6	04/10/2002	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
5	03/28/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
4	03/07/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
3	01/28/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
2	11/07/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	11/07/2001	INITIAL EXAM TEAM NN			

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